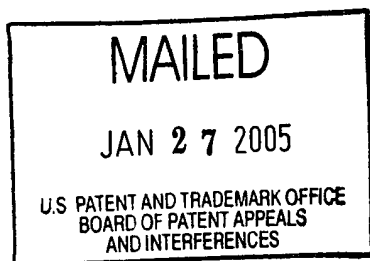


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte NIMROD MEGIDDO

Appeal No. 2004-1913  
Application No. 09/533,325

ON BRIEF

Before, RUGGIERO, BARRY, and LEVY, Administrative Patent Judges.  
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1, 4, 9, 10, 12, 13, 15, 16, 21, and 22, which are all of the claims pending in the present application. Claims 2, 3, 5-8, 11, 14, and 17-20 have been canceled. An amendment filed March 17, 2003 after final rejection was approved for entry by the Examiner.

The claimed invention relates to the management of contingency agreements or contracts in which an agreement is entered into the system, conditions for the agreement are logged, and potential

Appeal No. 2004-1913  
Application No. 09/533,325

responses and their locations which would satisfy the conditions are identified. Information is retrieved from the identified locations in accordance with milestones which are set to determine when to check whether a condition has been satisfied.

Claim 1 is illustrative of the invention and reads as follows:

1. A commerce management method for automatically managing agreements including one or more contingencies, said method comprising the steps of:

a) logging at least one condition for an agreement and identifying at least one potential response as indicating satisfaction of said at least one condition;

b) retrieving information related to responses to each condition from independent sources;

c) checking said retrieved information to determine whether said agreement is determinate; and

d) notifying contracting parties when said agreement is determined to be determinate.

The Examiner relies on the following prior art:

Leymann et al. (Leymann)	6,122,633	Sep. 19, 2000 (filed Apr. 20, 1998)
Minder	6,144,943	Nov. 07, 2000 (filed Oct. 21, 1997)
Gundewar et al. (Gundewar)	6,381,610	Apr. 30, 2002 (filed Jan. 22, 1999)

Blanche Evans (Evans), "Electronic Transactions Are the Future, Says NAR President," Realty Times, printed from web site <http://www.realtytimes.com>, 1-5, (March 1999).

Appeal No. 2004-1913  
Application No. 09/533,325

New York Times website (New York Times), printed from web site <http://www.archive.org>, 1-8, (1999).

Claims 1, 4, 9, 10, 12, 13, 15, 16, 21, and 22, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Minder in view of Gundewar and Evans with respect to claims 1, 4, 12, 13, 15, and 16, adds Leymann to the basic combination with respect to claims 9 and 10, and adds New York Times to the basic combination with respect to claims 21 and 22.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs<sup>1</sup> and Answer for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with

---

<sup>1</sup> The Appeal Brief was filed August 15, 2003 (Paper No. 16). In response to the Examiner's Answer dated November 18, 2003 (Paper No. 17), a Reply Brief was filed January 26, 2004 (Paper No. 18), which was acknowledged and entered by the Examiner as indicated in the communication dated April 15, 2004 (Paper No. 20).

Appeal No. 2004-1913  
Application No. 09/533,325

the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as recited in claims 1, 4, 9, 10, 12, 13, 15, 16, 21, and 22. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.,

Appeal No. 2004-1913  
Application No. 09/533,325

776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 1, 12, and 16, Appellant asserts that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art reference. After reviewing the arguments of record from Appellant and the Examiner, we are in general agreement with Appellant's position as stated in the Briefs.

Initially, we agree with Appellant (Brief, page 4) that Minder, in contrast to the claimed invention, is merely directed to a customer satisfaction reporting system in which a grade is assigned to a housekeeping service in relation to quality of service. While we don't necessarily disagree with the Examiners' summation (Answer, pages 4 and 5) of the operation of the system of Minder, we find no indication from the Examiner as to how such a

Appeal No. 2004-1913  
Application No. 09/533,325

summation would satisfy the language of the appealed independent claims. In addition to the claimed notification and independent resources features which the Examiner admits are missing from Minder, we fail to find in the Examiner's analysis where Minder discloses the logging of agreement conditions, the identification of potential responses, the retrieval of information related to the responses, and the checking of the retrieved information to determine whether an agreement is determinate. The Examiner must not only make requisite findings, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the asserted conclusion. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

We further agree with Appellant that, although the Examiner has cited the Gundewar and Evans references as providing a teaching of the claimed notification and independent resources features, no motivation for the proposed combination with Minder has been established. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

Appeal No. 2004-1913  
Application No. 09/533,325

As pointed out by Appellant, Gundewar is directed to a project management system in which various project team members are notified of the progress of a project as it proceeds through various stages while Evans is directed to a real estate transaction system in which various parties involved in a transaction communicate with each other. In our view, given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellant's own disclosure and not from any teaching or suggestion in the references themselves.

We have also reviewed the Leymann and New York Times references, applied by the Examiner to address the logging and particular retrieved information features, respectively, of several of the appealed dependent claims. We find nothing, however, in the disclosures of Leymann or New York Times which would overcome the previously discussed deficiencies of Minder, Gundewar, and Evans.

In view of the above discussion, in order for us to sustain the Examiner's rejection, we would need to resort to impermissible speculation or unfounded assumptions or rationales to supply deficiencies in the factual basis of the rejection before us. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967),

Appeal No. 2004-1913  
Application No. 09/533,325

cert. denied, 389 U.S. 1057 (1968), rehearing denied, 390 U.S. 1000 (1968).

Accordingly, since all of the claim limitations are not taught or suggested by the applied prior art references, we do not sustain the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 1, 12, and 16, nor of claims 4, 9, 10, 13, 15, 21, and 22 dependent thereon. Therefore, the decision of the Examiner rejecting claims 1, 4, 9, 10, 12, 13, 15, 16, 21, and 22 is reversed.

REVERSED

Joseph V. Spina

JOSEPH F. RUGGIERO  
Administrative Patent Judge

~~LANCE LEONARD BARRY~~  
~~Administrative Patent Judge~~

BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

Stuart A. Henry

STUART S. LEVY  
Administrative Patent Judge

JFR/lp



Appeal No. 2004-1913  
Application No. 09/533,325

MARK D. MCSWAIN  
IBM ALMADEN RESEARCH CENTER, IP LAW DEPT.  
650 HARRY ROAD  
CHTA/J2B  
SAN JOSE, CA 95120